

No. 20510

IN THE

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United States Court of Appeals
FOR THE NINTH CIRCUIT

AEROTEC INDUSTRIES OF CALIFORNIA, a corporation,
AEROTEC INDUSTRIES, INC., a corporation, UNIVERSAL
OIL PRODUCTS COMPANY, a corporation,

Appellants,

vs.

PACIFIC SCIENTIFIC COMPANY, a corporation,

Appellee.

APPELLANTS' REPLY BRIEF.

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APPELLANTS' REPLY BRIEF.

Plaintiff's voluminous Brief is an imposition on this Court (and Appellants) as it is an obvious attempt to divert Your Honors' attention from the basic and most important facts necessary to fairly and correctly determine this Appeal. In addition, Plaintiff uses irrelevant arguments, misrepresentations of fact and law, innuendoes and half-truths as substitutes for an open, fair and correct presentation of the evidence and law for Your Honors to consider.

In the interest of conserving the time of this Court, within the limited space available herein, Appellants will answer Plaintiff's Brief by setting forth some of the more important facts Plaintiff **did not controvert** in Appellants' Opening Brief, and also attempt to point out the most flagrant errors and misrepresentations in Plaintiff's Brief.

Plaintiff did not (and could not) refute or deny the following facts set forth in Appellants' Opening Brief:

- (a) that the four claims in issue of the two patents in suit require four elements:
 - (1) vehicle;
 - (2) safety device on the vehicle;
 - (3) cable; and
 - (4) object (p. 3 and Chart 1, p. 30 of Appellants' Op. Br.);
- (b) that this **same combination** of four elements is shown in the prior art patents such as Nordmark, Geohegan and Ham (Chart 1, p. 30 of Appellants' Opening Brief);
- (c) that patent '233 in suit teaches that **"objects other than human bodies, such as for example, freight, handling and the like"** (Ex. 1, Col. 7, lines 12-15) may be used to actuate the safety device which is element No. 2 in the combination set forth above;
- (d) that the **"object"** in the combination of elements set forth above may be a **man** (Nordmark or Geohegan prior art patents), an **occupant** (term used in claims in issue), **woman**, **chimpanzee** (admitted by Plaintiff's co-inventor Pfankuch, R. Vol. III pp. 297-98), **freight** (patent '223 in suit) or a **trolley pole** (Ham prior art patent);
- (e) that a **"human body is not needed"** to actuate the safety device in the **old combination of elements** set forth in Chart 1 opposite page 30 in Appellants' Opening Brief;
- (f) that objects **"other than human bodies"** will operate the safety devices in the patents in

suit or the safety device in the prior art patents to Ham (Appellants' Op. Br. p. 7);

- (g) that the safety device in the claimed combination of elements **"does not discriminate as to who or what applied the effective force"** (Appellants' Op. Br. p. 6);
- (h) that the Trial Court **ignored** the teachings of patent '233 in suit and refused to add a finding correctly quoting the patent — "objects other than human bodies" could be used — (Appellants' Op. Br. p. 6);
- (i) that the "equivalency of an inanimate object and a man to cause actuation is conceded by patent '233 in suit (Appellants' Op. Br. p. 11), and
- (j) that the device in the prior art patent to Ham (Ex. D) is a safety apparatus which is the title of the patents in suit.

In the view of these **uncontroverted** facts and regardless of all other arguments between the parties and differences of opinion between the witnesses, this Court should be compelled to find the claims in issue of the patents in suit invalid.

Since the co-inventors, Messrs. Pfankuch and Wrighton, of patent '233 taught that any object (man, freight, chimpanzee, trolley pole) could be used to actuate the safety device included in the claims in issue (and Plaintiff does not deny that fact), then it is obvious that the four claims in issue are directly readable on the Ham, Burdon or Ricketts patents (Ex. D) as graphically set forth in Exs. I to T and Appendix C, pages 1 and 2 in Appellants' Opening Brief. By merely changing the word "oc-

cupant” to an object or freight or trolley pole in each of the four claims in issue, it becomes obvious that the claims are invalid and the Trial Court erred.

Your Honors should now be fully aware of how Plaintiff argues that the claims in issue distinguish over the prior art as set forth on page 5 of Plaintiff’s Brief. Whenever the word “occupant” is used in conjunction with an element in the patent claims, then Plaintiff contends such element is not found in the prior art patents. Change “occupant” to “object” and the claims are fully met.

PLAINTIFF’S ALLEGED INVENTION IS IN A PHRASE NOT A MECHANICAL DEVICE.

Defendants have consistently maintained that Plaintiff concocted the meaningless phrase of “man-sensitive” in order to confuse the Trial Court and to attempt to distinguish the patents in suit from the prior art.

It is well settled that an invention can only be found in a mechanical device and not in an idea or phrase.

An idea, phrase, principle or concept is not patentable.

Kemart Corp. v. Printing Arts Research Laboratories, 201 F. 2d 624, 632 (C.A. 9, 1953);

Locw’s Drive-In Theatres, Inc. v. Park-In Theatres Inc., 174 F. 2d 547, 551 (C.A. 1, 1949).

“. . . It is the means for carrying out the idea that is patentable.”

Kruger v. Whitehead, 153 F. 2d 238, 239 (C.C.A. 9, 1946) cert. denied 332 U.S. 774.

Plaintiff has now admitted in its Brief that “The phrase ‘man-sensitive safety apparatus’ aptly describes plaintiff’s invention and distinguishes it over the prior

art vehicle-sensitive apparatus. The invention is not merely a cable locking mechanism as asserted by defendants." (Br. for Plaintiff-Appellee, p. 17).

Therefore, Plaintiff now admits that its invention is in the phrase "man-sensitive" rather than in a novel device which produces a new and surprising result as required by the patent laws and cases which have interpreted such laws. Plaintiff's sales department obviously may use the term "man-sensitive" as a crutch to sell safety devices but such phrase cannot be considered an invention. The Trial Court's Judgment must be reversed.

NO NEW OR SURPRISING RESULT IS FOUND IN PLAINTIFF'S SAFETY DE- VICES.

As required by the U. S. Supreme Court, a valid patent must disclose a device which produces a new or surprising result.

Graham v. John Deere Company of Kansas City,
383 U.S. 1 (1966);

*Great A & P Tea Co. v. Supermarket Equip-
ment Corp.*, 340 U.S. 147 (1950).

The **surprising result** found by the Trial Court for the patented safety devices in this suit was in **locking a man in his seat** (Find. 63, R. pp. 939-40).

However, **locking a man in his seat** is old and well-known as taught by the old safety devices in Nordmark '693 and Geohegan '653 (Ex. D) and as further shown on Chart 1 opposite page 30 in Appellants' Opening Brief. In both the Nordmark and Geohegan safety devices, the purpose and result was to

lock a cable against paying out and to hold a man from further movement which are the same purposes and results for the safety devices of the patents in suit.

Therefore, the required test of invention for the patented safety devices is not met and it is clear the Trial Court erred in finding the claims in issue of the patents in suit valid.

The Plaintiff in its Brief attempts to bring the present case under the umbrella of *United States v. Adams*, 383 U.S. 39. A careful reading of the *Adams* case will clearly disprove Plaintiff's erroneous statement that the facts here are similar to those present in the *Adams* case. Most important, Plaintiff fails to point out to Your Honors that in the *Adams* case, the defendant—U. S. government—admitted "that the Adams' battery 'wholly unexpectedly' has shown 'certain valuable advantages over other batteries' ". In the *Adams* case, there **was** a new or unexpected result which is **not** found and is certainly **not** admitted by the Defendants in this case.

COMBINATION OF ELEMENTS IN PATENTS IN SUIT IS OLD.

Plaintiff has conceded that the four elements claimed in the patents in suit are old and are shown in the Nordmark and Geohegan patents as set forth on Chart 1, opposite page 30 in Appellants' Opening Brief.

Plaintiff **did not invent** the combination of a vehicle, a safety device, cable having one end attached to the safety device, an object or man attached to the other end of the cable whereby the device functions to hold or lock a man in his seat, as

this combination is shown to be old in the Nordmark and Geohegan prior patents.

If Plaintiff's improvement in this old combination of elements was in the safety device, then the claims in suit are obviously invalid.

“ . . . and the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination.”

Lincoln Co. v. Stewart-Warner Corp., 303 U.S. 545, 549-50 (1937).

THE CLAIMED COMBINATION OF ELEMENTS WAS OBVIOUS.

Plaintiff attempts to rely on the biased testimony of its own employees (particularly its Chief Engineer, Glauser) to show the combination of elements set forth in the claims in suit would not have been obvious to one skilled in the art.

It is immaterial what Plaintiff's biased witnesses believed at the time of trial. These witnesses were **never** asked whether it would be obvious, **with the prior art patents before them**, to substitute an inertia-operated safety device as shown in the Ham prior art patent for the safety device used in the combination of elements shown to be old in the Nordmark or Geohegan patents prior to the filing in the U.S. Patent Office of the patents in Suit. This is the true test of obviousness under 35 U.S.C. §103 and *Graham v. John Deere Co.*, 383 U.S. 1.

A skilled mechanic with these prior art patents before him would find it not only obvious but the nor-

mal and expected substitution to make if he desired to obtain a combination of elements as taught by Nordmark or Geohegan with a safety device which was responsive to the abnormal movement on the cable caused by an object, *i.e.* trolley pole, freight, or man. Defendants' expert Gabriel clearly testified that this was an obvious combination (R. Vol. III, pp. 1555-57).

In accordance with the conditions of patentability and non-obviousness as set forth in 35 U.S.C. §103 and as interpreted by the U.S. Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 694, Plaintiff is not entitled to deprive the public of the right to freely use such old safety devices.

It was uniformly admitted by Plaintiff's witnesses, Pfankuch (co-inventor), Wrighton (co-inventor) and Henrikson, and confirmed by Defendants' witnesses, Gabriel and Swedlow, that the safety devices of the patents in suit would operate and work if installed on trolleys (R. Vol. III, pp. 231, 299, 363-65, 1556-57, 1507). The fact that the inventors did not make a search to avail themselves ". . . of knowledge stored in the Patent Office and readily available by the simple expedient of conducting a patent search." does not negate the test of obviousness as required by 35 U.S.C. §103 and *Graham v. John Deere Co.*, *supra*.

If the Plaintiff's co-inventors had known of the inertia-operated safety devices in the Ham, Burdon or Ricketts patents, it would have been obvious for them to utilize the teachings of such patents particularly in view of their own admissions subsequently that "objects other than human bodies" were contemplated as being used to actuate the mechanical safety device in the patents in suit.

MATTERS OF DEGREE ARE NOT PATENTABLE.

Plaintiff now argues in its Brief that the safety devices in the Ham, Burdon and Ricketts patents are heavy, large and bulky devices.

These are specious arguments and only relate to **matters of degree** as was admitted by Plaintiff's Chief Engineer, Glauser (R. Vol. III, pp. 1741-42) who agreed that a design engineer could make such changes.

"There is the old rule that one is not entitled to a patent who merely makes a change in form, proportion, or degree, by substantially the same means even though the changes he makes produce better results."

Kalich et al. v. Patterson Pacific Parchment Co.,
137 F. 2d 649 (C.A. 9).

Also see:

Talon, Inc. v. Union Slide Fastener, Inc., 266
F. 2d 731 (C.A. 9).

PLAINTIFF'S ALLEGED INVENTION— "MAN-SENSITIVE"—IS DIFFERENT OR NEW USE OF AN OLD DEVICE.

A classic example of how Plaintiff has attempted to divert Your Honors' attention from the basic issues of this case is Plaintiff's deliberate omission from its Brief (with the one exception of a sentence on p. 18) of any argument attempting to refute Defendants' position that Plaintiff's alleged invention (man-sensitive) is merely a **different or new use of the old safety device taught by Ham, Burdon or**

**HAM, BURDON AND RICKETTS PRIOR ART
PATENTS ARE MORE PERTINENT THAN
PATENTS CONSIDERED BY PATENT OF-
FICE.**

All of the pertinent prior art patents found, considered and cited by the Patent Office related to safety devices for use with cows and fire escapes, such devices **not being mounted on moving vehicles** nor being responsive to acceleration on the cable. On page 68 of Plaintiff's Brief, Plaintiff states: "However, the patents cited by the Patent Office are more pertinent than the trolley catcher patents and hence the presumption of validity is not affected."

This statement by Plaintiff is incorrect. Each of the patents to Ham, Burdon, and Ricketts show a **vehicle mounted** inertia-operated safety device responsive to abnormal acceleration on the cable by an object to cause a lock-up. **Not one patent considered by the Patent Office taught this combination of elements.**

No presumption of validity attaches to the patents in suit since these more pertinent prior art patents were never considered by the Patent Office.

Your Honors may therefore review this case with these new and more pertinent prior art patents **de novo** ignoring any presumption of validity.

PLAINTIFF'S ATTACK ON DEFENDANTS AND WITNESSES IS UNWARRANTED.

The unjustified attack by Plaintiff in its Brief on Defendants and their witnesses illustrates in what desperate straits Plaintiff finds itself after reading Appellants' Opening Brief.

Mr. Gabriel is a respected member of the California Bar and has practical experience in mechanical devices as well as in patent law. Mr. Swedlow, at the time of trial, was only months away from receiving his Doctorate degree in Engineering from California Institute of Technology and had a great deal of practical engineering experience.

Neither of these two witnesses worked for Defendants prior to the Trial, at which time their opinions were given with no strings attached to Defendants subsequent to the Trial.

On the other hand, Plaintiff's main witnesses were salaried employees of Plaintiff, prior, during and subsequent to the Trial.

Therefore, greater credibility must be given to Defendants' witnesses than Plaintiff's salaried employees.

Plaintiff raises an irrelevant issue as to the number of witnesses Defendants produced at the Trial. Plaintiff **fails** to point out to Your Honors that Defendants subpoenaed at the time of Trial Messrs. Pfankuch, Wrighton and Lutrell as their own witnesses (R. Vol. III, pp. 5 and 6) and further produced Messrs. Lautier and Spielman for the taking of their depositions by Plaintiff prior to the Trial. The depositions of Defendants' witnesses Lautier and Spielman were introduced into evidence as Exhibits 133 and 134. Plaintiff was

given full opportunity to question Defendants' witnesses, Lautier and Spielman, who had knowledge of the development of Defendants' device and which is set forth in Exhibits 133 and 134, part of the record on appeal. Since such witnesses resided and worked in Connecticut, there was no further need for their presence at the Trial as their depositions were introduced into evidence.

Defendants will not attempt to refute the many other misrepresentations and erroneous statements as to fact and law made by Plaintiff. In most instances the same tactics by Plaintiff were employed in the Trial Court.

Defendants clearly pointed out Plaintiff's misrepresentations in their Brief After Trial and refer Your Honors to Vol. Two-C, pages 800-807 of the record which is set forth herein at the end of this Brief as Appendix D. Defendants point out at least thirteen errors or misrepresentations of fact and law by Plaintiff (see Appx. D) which apply equally as well in answering Plaintiff's Brief at this time, particularly as to who was the inventor of patent '234; facts and law on file wrapper estoppel; the attack on Defendants' witnesses; and royalties used for commercial success.

NO EVIDENCE OF COPYING BY DEFENDANT.

Plaintiff has made many misrepresentations in its Brief that Defendants have copied Plaintiff's device. **There is no evidence nor even a finding of fact to support such misrepresentation.** During the depositions of Messrs. Lautier and Spielman (who designed Defendants' device) it was clearly established that Defendants had never seen the internal construction of Plaintiff's device. See pages 56-57 of

Lautier's testimony (Ex. 133) and page 18 of Spielman's testimony (Ex. 134).

Your Honors need only to compare Defendants' and Plaintiff's devices as shown on pages 1, 2 and 3 of Appendix C in Appellants' Opening Brief to be convinced that there was no copying.

The evidence establishes that there was no copying. Plaintiff's own witness, Rischard, admitted that Plaintiff's and Defendants' devices **"don't look alike"**. (Vol. III, p. 263) The Trial Court did not have a finding on copying even though the findings were prepared by Plaintiff's counsel who now misrepresents there was copying by Defendants. This is another example of the diversionary tactics employed by Plaintiff in its Brief.

DEFENDANTS' DEVICE IS NOT AN INFRINGEMENT.

At the time of Trial, Plaintiff did not introduce into evidence any claim charts which could be attacked by Defendants. Plaintiff now presents to this Court Claim Charts (App. G) **which are not in evidence**. The only reason for the **"No"** on such Charts (App. G) is because the word **"occupant"** was used in the claims. **By changing the word "occupant" to "object", the claims are fully met** (Exhs. U to X).

Plaintiff fails to answer Defendants' argument as to non-infringement on pages 47-49 of Appellants' Brief. Each claim in issue requires (1) a reel, (2) a locking pawl or means, and (3) an inertia member (separate). These are three separate elements. Exhibits U to X clearly illustrate that **Defendants' de-**

vice does not have an inertia member (the blue colored element).

The file histories of the patents in suit estop Plaintiff from reading three elements in the claims in issue on only two elements in Defendants' device. There is no difference of opinion between the witnesses as to whether a file wrapper estoppel exists as Mr. Glauser, Plaintiff's Chief Engineer, had no knowledge of patent procedures (R. Vol. III, pp. 526, 982, and 990).

Plaintiff is attempting to further mislead Your Honors by stating on page 43 of its Brief that:

"These claims were amended **slightly** by a paper filed in the Patent Office on May 10, 1956 (See p. 73, Ex. 134)." (Emphasis added.)

This statement is an attempt by Plaintiff to refute Defendants' arguments as to file wrapper estoppel as set forth on pages 53 through 55 of Appellants' Opening Brief.

The **slight** amendment that Plaintiff refers to was where Plaintiff added the **separate inertia member** to claims 23 and 25 which issued as claims 7 and 9 of patent '233 in suit. The **slight** amendment referred to by Plaintiff created a **file wrapper estoppel** which now estops Plaintiff from contending that Defendants' device is an infringement because **Defendants' device has no inertia element separate from the reel and the locking pawl** (see Exs. U to X and note that Defendants' device illustrated therein has no inertia element colored blue).

Plaintiff refused to cross-examine Mr. Gabriel (Defendants' patent expert) on his testimony relating to file wrapper estoppel. Plaintiff's reason is that these

are matters of law and not fact. What actually occurred in the Patent Office and what was added by amendment are questions of fact which have not been refuted by any witness for Plaintiff. Mr. Gabriel's testimony stands uncontroverted.

Plaintiff attempts to minimize Mr. Gabriel's expert testimony by quoting on page 23 of its Brief a paragraph from a book entitled "Patent Law Annual" published in 1966 by Matthew Bender & Company, on page 128 thereof. However, the paragraph following the paragraph quoted by Plaintiff in the "Patent Law Annual" is as follows including the footnotes:

"Because of these factors, it is inadvisable in the ordinary case to use a patent attorney, or one whose only or primary claim to expert knowledge is in the area of patent law. However, it should be noted that despite the danger that a court will consider opinion testimony from an attorney or 'patent' expert an invasion of its exclusive province, some judges are not at all jealous of their prerogatives and welcome the help of one who offers knowledge of the law of patents as well as a scientific or technical background. For example, Judge Brown of the Fifth Circuit in the celebrated case of *Bros, Inc. v. W. E. Grace Manufacturing Co.*⁸ referred to the patentee's 'engineer-lawyer-expert witness' and his 'analysis, element by element, carefully articulated and graphically portrayed' which demonstrated that the device of the patent in suit was not disclosed by a publication which was asserted as a statutory bar.⁸ Of similar interest is the

⁸351 F.2d 208 (5th Cir. 1965)

comment in the case of Jeoffroy Manufacturing, Inc. v. Graham.⁹ to the effect that the 'force which might otherwise attach to the eminent trial court's conclusion as to invalidity, insofar as based on testimony by Jeoffroy's witness, Witherspoon, . . . seems to us considerably weakened by the fact that this witness was admittedly not a patent expert, but only an engineer testifying for his first time in a patent suit.¹⁰

⁹219 F.2d 511 (5th Cir. 1955).

¹⁰While we recognize that the weight to be accorded the testimony of this witness was primarily for the trial court, we still believe it is an appropriate fact for our consideration in reviewing the trial court's finding of invalidity in what appears to us a close case."

If Your Honors find these claims in issue valid, then Defendants' device must be found not to be an infringement in view of the limitations in the claims, the file wrapper estoppel, and the difference in mode of operation between the devices.

CONCLUSION.

Plaintiff has attempted to convince Your Honors that in effect an aircraft could not fly without one of the patented safety devices being used. The safety device of the patents in suit is merely one of thousands of pieces of hardware that may be used on an aircraft, any one of which being dispensable.

These safety devices are only installed on the crew seats and not on passenger seats. In most instances, the pilot refuses to wear the harness straps attached to the safety device because they do not allow him the freedom of movement he desires. Therefore, such safety

device is not operable. Despite Plaintiff's imaginative but exaggerated arguments, the patented safety device is merely a mechanical safety device for locking a cable when abnormal acceleration is encountered by an object attached to the cable or straps.

Your Honors should not be diverted from the basic issues of invalidity and non-infringement by the diversionary Brief filed by Plaintiff.

Plaintiff's complete failure in answering Defendants' basic arguments is indicative of the weakness of Plaintiff's alleged invention **which is in a phrase, namely "man-sensitive"**. Should additional patents be granted for the old safety devices shown in the Ham, Burdon or Ricketts patents if they were used with new or different objects such as a chimpanzee, freight or any other object capable of accelerating a cable?

Plaintiff has merely used an old safety device for a different use (man-sensitive) but this is not an invention.

The claims in issue are no more than the sum of the prior art freely available to all persons who had knowledge of such prior art.

The District Court was misled by a concocted phrase, **"man-sensitive"**, and failed to make complete and detailed findings as required by the Rules and this Court of a new result, of the mechanical differences not found in the prior art, and of what patent '233 taught as to use of the safety devices with **"objects other than human bodies"**. Would the Trial Court have held the patents in suit valid if the safety devices were **"freight-sensitive"** as taught by patent

'233? By failing to amend the findings, the Trial Court was closing his mind to the true facts.

The Trial Court's conclusions of validity and infringement of the claims in issue of patents '233 and '234 should be reversed with costs.

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Certificate.

I certify that, in connection with the preparation of this brief, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

WILLIAM POMS



APPENDIX D.



APPENDIX D.

PLAINTIFF'S MISREPRESENTATIONS OF FACTS AND LAW

At the trial and in "Plaintiff's Memorandum," plaintiff's counsel have deliberately and falsely represented both facts and law to this Court in direct violation of their duty as an Officer of this Court.

These misrepresentations are as follows:

1. During final argument, plaintiff's counsel deliberately and falsely misrepresented to this Court ". . . that **both** of the inventors of the '234 patent, Messrs. Cushman and Wrighton, **constructed a model** which is very, very similar to the device in suit. I hold before the Court here Exhibit 64.

"This device was **made** and seen by **both** the inventors of the '234 patent long before that patent was filed in the Patent Office." (Prout, R. 1768)

This statement is proven to be **false** by Mr. Prout's own direct-examination of Mr. Wrighton:

"Q And who made the device?

"A **Mr. Cushman.**" (R. 337)

"Q Did Mr. Cushman, come up with this device completely independently of your work on the '234 device?

"A Yes, that was an **independent** effort on Mr. Cushman's part." (R. 338)

It is obvious that plaintiff's counsel was in **bad faith attempting** to overcome defendants' Exhibits AI and AJ and Mr. Gabriel's testimony that the '234 patent was invalid because the claims were covered

by the Cushman model Exhibit 64; also see pages 29 to 32 of this brief.

On page 1793 of the trial record, defendants' counsel called this Court's attention to this **false misrepresentation** by plaintiff's counsel and said: [800]

"That is a misrepresentation, your Honor, and as an officer of this Court he ought to explain it." (R. 1793)

The **failure** of plaintiff's counsel to stand up and explain his false statement is **proof of his intent to deceive** this Court.

2. In final argument (R. 1837, ls. 1-8) plaintiff's counsel made a completely false statement as to what is not file wrapper estoppel. A reading of any cases on file wrapper estoppel, such as those set forth on pages 50 and 53 of this brief, will prove the falsity of this statement.

3. On page 2 of "Plaintiff's Memorandum," plaintiff falsely represents that the "witnesses received only such testimony as defendants' lawyers elected to turn over to them" (ls. 15-16) and that "they were willing to testify in accordance with the desires of defendants' lawyers" (ls. 23-25).

These false and irresponsible statements **cannot be supported by any facts, testimony or the record.**

Defendants' experts are both reputable men in their respective fields and sat through the entire trial. Their testimony was based on their own independent conclusions in view of all of the evidence and testimony introduced at trial.

4. Throughout "Plaintiff's Memorandum," plaintiff misrepresents that defendants deliberately copied the device in the patents in suit.

As set forth hereinabove, defendants' device is entirely different in elements, function and operation than the patented device. **There was not a scintilla of evidence or testimony as to such copying.**

Plaintiff's own witness Rischard even admitted on cross-examination, "No. They don't look alike." [801]

5. Plaintiff misrepresents that the early Cushman model Exhibit 64 was **incomplete** ("Memorandum," page 21, line 9), thus implying it was inoperative.

However, on direct-examination Mr. Glauser **successfully operated** Exhibit 64 for plaintiff's counsel (R. 729) and on cross-examination successfully operated this model two more times (R. 816-17).

6. Plaintiff misrepresents that there is no statement in the file history that the locking means is solely the pawl ("Memorandum," pg. 37, ls. 23-24).

The file history of the '233 patent (Exh. 131) definitely shows that plaintiff interpreted the locking means in the claims to be "pawl 58" (Exh. 131, pgs. 58, 70, and 71).

7. Plaintiff attacks Mr. Gabriel ("Memorandum," pgs. 39-41) and falsely states that he "ignored all settled laws" on file wrapper estoppel and relies on *Taylor-Reed Corp. v. Mennen Products, Inc.*, 324 F. 2d 108, and *D and H Electric Co. v. M. Stephens Mfg. Inc.*, 233 F.2d 879, to support the unwarranted and false attack on Mr. Gabriel, a respected member of this Bar for many years.

In the first case, *Taylor-Reed Corp.*, plaintiff's attorney attempts to mislead this Court by merely quoting the passages on pages 40 and 41 of Plaintiff's Memorandum without revealing to this Court what the court held and the other facts of this case. The court in *Taylor-Reed Corp.* actually found that file wrapper estoppel existed and reversed the lower court and held the patent not to be infringed, which supports Mr. Gabriel's position.

The court in *Taylor-Reed* also said:

"So, in this case, where the plaintiff seeks to broaden its claim by dropping the limiting elements the patentee introduced in order to overcome the rejection [802] of prior claims as invalid under the cited prior art, such amended claim must be strictly construed against the inventor and it may not be given the larger scope claimed prior to amendment by construction or resort to the doctrine of equivalents."

The *Taylor-Reed Corp.* case fully supports Mr. Gabriel and his testimony that the separate inertia element was required to be added to claims 7 and 9 (23 and 25 in the application, Exh. 131) of patent '233 in order to overcome the Sharpe patent. Plaintiff misapplies and misrepresents the effect of *Taylor-Reed Corp.*, which supports rather than contradicts Mr. Gabriel's expert opinion and testimony.

Plaintiff on page 41 of its "Memorandum" also attempts to rely on the *D and H Electric* case in attacking Mr. Gabriel. Here, again, the Ninth Circuit

Court of Appeals held the patent not to be infringed because of file wrapper estoppel and the court said:

“Claims of a patent must be interpreted with reference to the history content of the file wrapper, which is nothing more than a written record of the preliminary negotiations between the applicant and the Patent Office for a patent monopoly contract.”

Mr. Gabriel did nothing more than what C.A. 9 has held in the *D and H Electric* case and in cases prior and subsequent thereto. Mr. Gabriel merely interpreted the entire file history, the amendments to the claims and the interpretations and admissions by the applicant (plaintiff here) in order to find the file wrapper estoppel.

Plaintiff's counsel has falsely represented that Mr. Gabriel does not know what the law is on file wrapper estoppel and by relying on *Taylor-Reed Corp., supra*, and *D and H Electric, supra*, has actually supported Mr. Gabriel's testimony. Mr. [803] Gabriel's expert testimony on file wrapper estoppel in this case is supported by one of the leading cases in the Ninth Circuit, *Moon v. Cabot Shops, Inc.*, 270 F. 2d 539 (1959), wherein the court held, and it has been followed in many cases since:

“. . . Claims of a patent must be construed not only in the light of the specification and drawings, but also with reference to the file wrapper history. *Whiteman v. Matthews*, 9 Cir., 216 F.2d 712, 715, 104 USPQ 83, 85. That is, the claims of the patent must always be explained by and read in connection with the specifications and in the light of definitions and admissions made by the applicant in the proceedings in the Patent Office.”

This unwarranted attack on Mr. Gabriel's testimony of the facts and law on file wrapper estoppel is inexcusable. Plaintiff misapplies the two cases he relies on, such cases actually supporting Mr. Gabriel's opinion and testimony.

8. On pages 41 and 42 of plaintiff's "Memorandum," plaintiff's counsel again without foundation attacks Mr. Gabriel's legal testimony and opinion as to whether the file wrapper estoppel in the '233 patent can be carried over into the '234 patent.

On pages 55, 56 and 57 of this brief, it was distinctly pointed out how plaintiff's counsel misrepresented to this Court the effect and holding in the *Temco Electric M. Co. v. Apco Mfg. Co.*, 275 U.S. 317, and *Bechik v. Handy Mattress Accessories Corp.*, 45 F.Supp. 73, cases. These two cases do not prove that Mr. Gabriel was incorrect in his testimony that file wrapper estoppel in the first patent should be carried over into the second patent. As pointed out at pages 55 to 57 of this brief, the U. S. Supreme Court in the *Temco* case had an incomplete record with which to decide this issue. In the *Bechik* case, the court could not find a file wrapper estoppel in the first case and therefore could not, [804] of course, carry it over into the second patent. However, there is a definite inference that this file wrapper estoppel would have been carried over if a file wrapper estoppel had been found in the first patent.

Therefore, the *Bechik* case actually supports Mr. Gabriel's testimony and certainly does not support the unwarranted attack on Mr. Gabriel as the case was misrepresented to this Court by plaintiff's counsel.

9. Plaintiff misrepresents on page 47 of its "Memorandum" that it has received approximately \$50,000 for sales of safety apparatus under foreign license agreements. As pointed out on page 41 of this brief, plaintiff's witnesses **could not divide** the royalties under the foreign license from the know-how and technical services required to be furnished by plaintiff in the sales of the safety apparatus.

10. Plaintiff attempts to mislead and misrepresent to this Court on pages 64 and 65 of its "Memorandum" that cords or ropes as disclosed in the Ham, Burdon and Ricketts patents are different and not the equivalents of a strap as allegedly used in the patents in suit.

The specification of the '233 patent (Exh. 1) clearly emphasizes this misrepresentation:

" . . . In the subsequent claims, it is intended that where the term 'cable' is used it is meant to encompass cables, and equivalents such as, for example, wire, rope, strap, etc." (Col. 7, ls. 19-22)

11. Plaintiff has cited a 1933 case, *H. K. Regar and Sons v. Scott & Williams, Inc.*, 63 F.2d 229, and 1927 case, *H. C. White Co. v. Morton E. Converse & Son*, 20 F.2d 311 (Memorandum pgs. 68-69) to support its position that new use of an old device is invention. These cases are misleading. [805]

Both of these cases are very old, and the law followed universally throughout the circuits today is as set forth on pages 18 to 20 of this brief to the effect that a **new use by plaintiff of an old safety device as disclosed by Ham, Burdon and Ricketts is not invention.**

12. Plaintiff on page 85 of its "Memorandum" alleges bad faith on the part of defendants in refusing to add Universal Oil Products Company in this action.

Such a statement from plaintiff and its counsel is without justification and clearly shows what desperate straits plaintiff is in to resort to this misrepresentation.

At the close of defendants' final argument on pages 1832 and 1833 of the trial record, it clearly appears that defendants' counsel voluntarily obtained authorization from Universal Oil Products to be added as a party defendant even though plaintiff had only jurisdiction over two non-existent defendants. Plaintiff's counsel knew of the relationship between Universal Oil Products and the other two defendants months before the trial started and did nothing.

Your Honor, recognizing that defendants' counsel was attempting to expedite this issue and prevent the filing of unnecessary motions, said:

"They concede that point, so you don't need to go into that." (R. 1833)

If there is any bad faith involved on this issue, it must be on the part of plaintiff and its counsel.

13. Plaintiff misrepresents in its "Memorandum After Trial" that defendants "did not produce a single witness who had direct knowledge of the facts" (pg. 2).

Defendants had subpoenaed Messrs. Pfankuch, Wrighton and Luttrell, who appeared on the first day of trial in answer to these subpoenas and who were excused by your Honor at the request of defendants (R. 5 and 6). [806]

These three witnesses subpoenaed by defendants did have direct knowledge of the facts, which completely contradicts the statements made by plaintiff.

In addition, plaintiff throughout its Memorandum After Trial has attacked defendants' other witnesses, Messrs. Gabriel and Swedlow, as being biased and paid experts. It should be noted by your Honor that Messrs. Gabriel and Swedlow are not employees of defendants but are independent experts who rendered their unbiased opinions based on their knowledge of all of the facts and after being in court during the entire trial.

In contrast, plaintiff's primary witnesses were all employees of the plaintiff company. In considering the credibility of all of the witnesses that testified during trial, it is obvious that plaintiff's witnesses would be more biased than Messrs. Gabriel and Swedlow, who were not employees of defendants and who are not obligated in the future to defendants.

There are other misstatements and scurrilous attacks on defendants, their counsel and witnesses, which will be ignored as they will unnecessarily prolong the Court's determination of the true issues of invalidity and non-infringement of the patents in suit. [807]